

Remarks

All pending claims (i.e., claims 1-31) stand rejected under 35 U.S.C. §103(a) as being obvious over Weir et al. (U.S. Patent No. 5,729,559; hereinafter Weir) in view of certain alleged “common knowledge” to one of ordinary skill in the art. This rejection is respectfully, but most strenuously, traversed and reconsideration thereof is requested.

Applicants request reconsideration and withdrawal of the obviousness rejection for at least the following grounds:

- (1) the Office Action fails to state a *prima facie* case of obviousness against Applicants’ claimed invention; and
- (2) Weir fails to teach or suggest various aspects of Applicants’ recited invention.

Failure to State a Prima Facie Case of Obviousness:

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants’ disclosure. (MPEP 706.02(j))

The initial burden is on the Examiner to provide some suggestion of the desirability of doing what the inventor has done. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

In view of these standards, Applicants respectfully submit that the Office Action fails to state a *prima facie* case of obviousness against the claims presented.

For example, Applicants recite a particular process for generating addresses having attributes associated therewith. In Applicants' process, there is a generating of at least one address based on at least one selection attribute to be used in selecting the at least one address. The selecting includes employing a filter specifying the at least one selection attribute employed in the generating. Further, the generating and the selecting are controlled to ensure that at least one address is selected that satisfies the filter.

In rejecting the subject matter, the Office Action asserts at page 2, paragraph 3 that ...

Weir et al. teaches a system and/or method comprising the means to enable a set of tests/verification patterns/factors (*which one of ordinary skill in the art understands may include addresses*) to be automatically generated a function of a set of defined constraints which may include goals associated with the simulated results derived from a tentative pattern/factor chosen from a list/sequence of pseudo-random values (*whose sequence, as understood by one of ordinary skill in the art, may be inherently affected by a correspondingly definable initial value and/or feedback polynomial*) and an arbitrarily complex state of a user defined model ... (Emphasis added.)

Initially, Applicants request that the Examiner more specifically document the alleged knowledge of one of ordinary skill in the art asserted in the above-highlighted parentheticals. This request is made pursuant to 37 C.F.R. §1.104(d)(2).

Further, Applicants respectfully submit that the Office Action fails to address the above-noted aspects of their recited invention. A careful reading of Weir and the Office Action fails to cover any discussion of a coupling between generating of an address and selecting of an address as recited by Applicants. More particularly, in Applicants' approach, there is a generating of at least one address based on at least one selection attribute to be used in selecting at least one address, and further, the selecting includes employing a filter specifying the at least one selection attribute. Thus, in accordance with Applicants' invention, there is a tight coupling between the addresses that are generated and the addresses that are ultimately selected using the at least one selection attribute. A careful reading of the Office Action and the Weir reference fails to uncover any teaching or suggestion of tying of the generating process with the selecting process using the at least one selection attribute. Further, a careful reading of Weir fails to uncover any teaching or suggestion of generating an address *per se*, let alone generating an address based on at least one selection attribute to be used in selecting the address. This aspect, clarified in the amendment submitted herewith, does not appear to be addressed by the Office Action.

Still further, Applicants' independent claims recite that the generating and the selecting are controlled to ensure at least one address is selected that satisfies the filter. A careful reading of the Office Action and the Weir patent fails to uncover any teaching or suggestion of this concept. Since this aspect of Applicants' recited invention is not addressed in the Office Action, Applicants respectfully submit that a *prima facie* case of obviousness has not been stated. Applicants' controlling of the generating process is essentially a feedback mechanism whereby at least one address is ensured to be generated for selection using the filter. No similar control mechanism is believed taught or suggested by the applied and known art.

For at least the above-noted reasons, Applicants respectfully request reconsideration and withdrawal of the obviousness rejection stated in the initial Office Action.

Weir Lacks Any Teaching or Suggestion of Various Aspects of Applicants' Invention:

An "obviousness" determination requires an evaluation of whether the prior art taken as a whole would suggest the claimed invention taken as a whole to one of ordinary skill in the art. In evaluating claimed subject matter as a whole, the Federal Circuit has expressly mandated that functional claim language be considered in evaluating a claim relative to the prior art. Applicants respectfully submit that the application of these standards to the independent claims presented leads to the conclusion that the recited subject matter would not have been obvious to one of ordinary skill in the art based on the applied patent.

For example, Applicants recite a particular process for providing addresses to be used in a verification environment. A careful reading of Weir fails to uncover any teaching or suggestion of generating addresses *per se* for a verification environment. Weir is directed to generating patterns/vectors and does not discuss generating addresses specifically, let alone the particular process for generating addresses, as recited by Applicants.

In Applicants' invention, the generating of one or more addresses is based on at least one selection attribute to be used in selecting the one or more addresses. A careful reading of Weir fails to uncover any teaching or suggestion of this aspect of Applicants' invention. Again, Applicants are discussing generating addresses *per se*, and more particularly, generating at least one address based on at least one selection attribute to be used in selecting at least one address. There is no discussion of Weir of basing generation of at least one address on at least one

selection attribute to be used in selecting the at least one address. Applicants respectfully submit that generating a test vector based upon a defined constraint is not a teaching or suggestion of the specific facility recited by Applicants. A careful reading of Weir fails to uncover any teaching or suggestion of tying generating of an address to a particular selection attribute to be employed in a filter used in selecting an address.

Still further, a careful reading of Weir fails to uncover any teaching or suggestion of an address generating facility, such as recited by Applicants, as well as the particular selecting being controlled to ensure at least one address is selected that satisfies the filter. Again, this aspect of Applicants' invention does not appear to be addressed in the Office Action.

For at least the reasons noted above, Applicants respectfully submit that the independent claims patentably distinguish over the applied art. The dependent claims are believed allowable for the same reasons as the independent claims, as well as for their own additional characterizations. In this regard, Applicants respectfully request that each of the dependent claims be examined on its own merit.

In claim 7, Applicants recite that the one or more attributes and the at least one selection attribute specified to the filter are maintained in a same class. A careful reading of Weir fails to uncover any teaching or suggestion of classifying attributes *per se*, let alone classifying attributes associated with addresses generated.

In claim 8, Applicants recite that the selecting includes employing a *user-defined* selector function to select at least one address. A user-defined selector function as used in the present application comprises a piece of software code that is used to select the at least one address. A careful reading of Weir fails to uncover any teaching or suggestion of software code that is user-defined being used to select at least one address.

In claim 9, Applicants recite that the at least one attribute enables one or more generated addresses having the at least one attribute to be assigned to a particular requestor. Thus, in Applicants' invention, generated addresses can be associated with particular requestors. No similar facility is provided by the teachings of Weir.

In claim 10, Applicants recite that the selecting includes creating a list of the at least one address satisfying the filter, and *dynamically changing the list in response to a change to one or more attributes of the one or more generated addresses*. A careful reading of Weir and the known art fails to uncover any teaching or suggestion of a facility for accomplishing dynamically changing of such a list responsive to a change in one or more attributes of the one or more generated addresses.

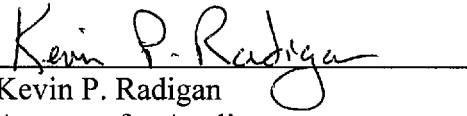
To the extent that the Examiner alleges inherency in one or more aspects of the independent claims and/or dependent claims, Applicants request clarification. The doctrine of inherency is well settled in patent law. In relying on the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic *necessarily* flows from the teachings of the applied prior art. The Office Action fails to present a convincing line of reasoning that any of the alleged inherent aspects of Applicants' recited facility *necessarily* flows from the teachings of Weir, and thus, fails to state a *prima facie* case of obviousness against the claims at issue.

With respect to the parenthetical reference to U.S. Patent No. 6,292,765 contained at page 3 of the Office Action, Applicants request clarification. If a reference is relied upon to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection. Applicants respectfully request clarification of the basis for the rejection to the extent that the Examiner may be relying upon this patent for the rejection. (MPEP 706.02(j)).

All claims are believed to be in condition for allowance, and such action is respectfully requested.

Applicants' undersigned attorney is available should the Examiner wish to discuss this application further.

Respectfully submitted,


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